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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,284	10/11/2000	Andrea C. Hughs-Baird	0112300/143	5144

29159 7590 11/04/2002

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EXAMINER
ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/686,284	HUGHS-BAIRD, ANDREA C.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-34 and 36-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15-34 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *31 July 2002* is: a)☒ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

MARK SAGER
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 31 July 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term 'X' is not defined sufficiently to distinctly claim the invention.

Claim Rejections - 35 USC § 103

Claims 1, 2, 5, 8-11, 20, 23, 27-30 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al., U.S. 6,322,309 (Nov. 27, 2001) (hereafter "*Thomas*") in view of *Tic-Tac-Dough*, <www.angelfire.com/-wrestling3/jay_anton/tictackpages/tictacdough.html> (describing the television game show TICK-TAC-DOUGH© by Jack Barry and Dan Enright Productions, a division of Sony Pictures Entertainment airing from 1978-1986) and Walker et al., U.S. Patent 6,174,235 B1 (Jan. 16 2001) (hereinafter "*Walker*")

In regards to claims 1, 10, 20, 27 29, 36 and 38: *Thomas* teaches a gaming device having a bonus scheme wherein a plurality of hidden selections associated with symbols are presented to a player on a

display and players successively pick selections to generate outcomes. If the player selects credit symbol, he is awarded a payoff. If a player selections a terminating symbol, the game ends. In one embodiment derived from the board game MONOPOLY ™, selections are associated with sets that, when completed, provide an additional payoff. *See col. 11:38-65.* The sets are associated with various payoff amounts. *See id.* In particular regards to the claims, the reference describes the following features:

a. A plurality of selections. *See fig. 8, 9.*

b. A plurality of credit symbols associated with the selections. *See id.*

c. A display device adapted to display selections to a player. *See fig. 8, 9, 12-14.*

d. A processor that communicates with the display device, provides a number of credits to the player when the player chooses each of the selections having an associated credit symbol. *See id.*

e. Allowing the player to make a number of picks from the display; crediting player an amount associated with each pick having an associated credit symbol; accumulating the award symbols from each pick having an associated award symbol; and providing the player an award based on the number of accumulated award symbols wherein the award increases non-linearly as the number of accumulated award symbols increases. *See fig. 8; col. 9:55-11:65.*

However, *Thomas* lacks the following features:

a. A plurality of award symbols.

b. A winning combination of award symbols and a jackpot award associated with the winning combination of award symbols, the winning combination of award symbols requiring a number of said award symbols.

c. Accumulating the award symbols when the player chooses each selection having an associated award symbol.

d. Providing the player a jackpot award when the accumulated award symbols reach the winning combination of a number of award symbols and provides the award if the accumulated award symbols have less than a number of award symbols.

Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

Tic-Tac-Dough describes an analogous gaming device having a selection-type bonus game wherein a player makes a number of picks from a display containing an array of selections. Selections include credit symbols, award symbols and functional symbols. The award symbols, labeled 'Tic' and 'Tac', are associated in a set. *See pp. 6-7.* If the player accumulates both award symbols, he is paid a jackpot. Generally, *Tic-Tac-Dough* teaches a selection game having a mix of credit symbols and award symbols wherein a jackpot award associated with accumulated award symbols. In specific regards to the claims, the reference describes the following features:

a. A plurality of credit and award symbols. *See pp. 6-7*

b. A winning combination of award symbols and a jackpot award associated with the winning combination of award symbols, the winning combination of award symbols requiring a number of said award symbols. *See id.*

c. Accumulating the award symbols when the player chooses each selection having an associated award symbol and providing the player a jackpot award when the accumulated award symbols reach the winning combination of award symbols.

The suggestion to combine the above fatures of *Tic-Tac-Dough* with *Thomas* is within the general knowledge held by a gaming artisan because (i) *Tic-Tac-Dough* discloses an analogous secondary game and (ii) it is common in the art to adapt television game show features and rules into gaming devices. Thus, in view of *Tic-Tac-Dough*, it would have been obvious to one or ordinary skill in the art at the time of the invention to modify the gaming device in *Thomas* to add the features of a winning combination of

award symbols and a jackpot award associated with the winning combination of award symbols, the winning combination of award symbols requiring a number of the award symbols and accumulating the award symbols when the player chooses each selection having an associated award symbol and providing the player a jackpot award when the accumulated award symbols reach the winning combination of a number of award symbols. As taught by *Tic-Tac-Dough*, the modification would enhance the selection-type game disclosed by *Thomas* by offering greater variety of selections and the potential larger awards. As a result, operator revenue there from increased player interest.

The combination of *Thomas* with *Tic-Tac-Dough* describes all the features of the claims except paying an award if the accumulated award symbols have less than a jackpot-winning number of award symbols. Regardless of the deficiency, the feature were known in the art at the time of the invention and would have been obvious to an artisan.

Gaming devices such as fruit machines typically generate outcomes comprised of randomly selected award symbols. These outcome combinations are commonly associated with different prize levels depending on the kind and number of award symbols. *See, e.g., Thomas, fig. 3.* For example, an outcome of three "seven-jackpot" elements may generate a jackpot payoff; whereas an outcome of two "seven-jackpot" elements and one "seven" element may generate a lower payout. *See id.* Hence, it is known in art to provide outcomes where award symbols provide a jackpot-level and a winning combination of fewer award symbols provides a lesser award. Generally, paying awards based on various combinations of award symbols enhances a gaming device by increasing the number of possible outcomes. Furthermore, the award combinations make a game more interesting for players by generating feelings of anticipation as the outcome are revealed.

Walker discloses an analogous selection game wherein random game outcomes are generated by players who select a predetermined number of hidden outcomes presented on a display. The selections

constitute award symbols that are accumulated by the gaming device upon selection to determine an award. *See fig. 9.* For example, an outcome of three "seven" elements may generate a jackpot-level payoff. *See fig. 3; col. 5:56-6:10, 7:1-15.* Generally, *Walker* teaches having a plurality of award symbol selections wherein different combinations of award symbols are associated with different levels of awards.

In sum, it is known in the art to provide selection games wherein different outcome selections are accumulated to generate different payoffs, including jackpots. Thus, in view of *Walker*, it would have been obvious to modify the selection-type game described by the combination of *Thomas* and *Tic-Tac-Dough*, wherein award symbols accumulate to generate a jackpot payoff, to add the feature of providing an award if the accumulated award symbols have less than a number of award symbols. As is well understood in the art, paying awards based on various combinations of outcome selections enhances would enhance the gaming device by increasing the number of possible outcomes and provide players with a feeling of anticipation as the outcome combinations are revealed.

In further regards to claim 10: *Walker* additionally teaches a selection game wherein players are provided a predetermined number of selections and the selection steps are repeated until the number of selections are picked. *See col. 7:1-15.*

In further regards to claim 20: *Tic-Tac-Dough* and *Walker* additionally teach providing the player with an amount of credits for at least two picks of the selections associated with the award symbol. *See, e.g., Walker, col. 7:1-15.*

In further regards to claims 27 and 29: *Walker* additionally teaches providing a player an award that varies based on the number of accumulated award symbols associated with the selections picked by

the player wherein the number is at least two and the award increased non-linearly as the number of award symbols increases. More specifically, *Walker* describes a selection-type game in which players select at least two award symbols to generate an award analogous to a fruit machine. Fruit machines commonly have awards that increase non-linearly as the number of award symbols increase. *See, e.g., Thomas, fig. 3.* Although not, explicitly disclosed by *Walker*, it is implicit that the award symbols picked by the player are associated with a pay-table that increases awards non-linearly as the number of award symbols increase. *See id.*

In regards to claim 2, 9 and 28: *Thomas* discloses accumulating awards associated with subsequent selections wherein credits may be associated with any of the selected outcomes. *See col. 11:29-36.*

In regards to claims 5, 15and 23: *Thomas* discloses a functional "party pooper" symbol performing the function of ending the player's selections. *See col. 12:6-24.* Likewise, *Tic-Tack-Dough* discloses a "dragon" symbol performing the function of ending the player's selections. *See pp. 6-7.*

In regards to claim 8 and 37: *Walker* discloses a plurality of related award symbols defining winning combinations of award symbols that can be selected within the number of picks. *See col. 7:1-15.*

In regards to claim 11: *Thomas*, *Tic-Tac-Dough*, and *Walker* enable players to pick selections. *See, e.g., Walker, col. 7:1-15.*

In regards to claim 30: *Tic-Tac-Dough* discloses an additional award that includes a jackpot. *See pp. 6-7.*

Claims 3, 4, 12, 13, 21, 22, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thomas* with *Tic-Tac-Dough* and *Walker*, as applied to claims 1, 2, 5, 8-11, 20, 23, 27-30 and 36-38 above, in further view of Mayeroff, U.S. Patent 6,231,442 (May 15, 2001) (hereinafter "*Mayeroff*").

The combination of *Thomas* with *Tic-Tac-Dough* and *Walker* discloses all the features of their respective claims except (a) means for determining the number of selections in the bonus game based on player's wager in the primary game; and (b) providing a sufficient number of selections to allow the player to select award symbols necessary for obtaining a winning combination. Regardless of these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Mayerhoff discloses a gaming device with an analogous selection-type bonus scheme. The number of selections in the bonus game is based on the player's wager in the primary game. See col. 7:47-52. *Mayerhoff* suggests that this method motivates players to increase their primary wagers. *See col. 3:57-60. (Claims 3, 12, 21, and 31)* It is implicit within the disclosure that number of selections provided is sufficient to allow a player to win in the secondary game. *(Claims 4, 13, 22, and 32)*

Thus, in view of *Mayerhoff*, it would have been obvious to one skilled in the art at the time of the invention to modify the selection game described by the combination of *Thomas* with *Tic-Tac-Dough* and *Walker* to add the features of basing the number of selections in the bonus on the player's wager in the primary game to motivate players to increase their wagers to gain more selections to receive greater odds of a bonus payoff and thereby increase operator revenue from the increased wagers.

Claims 6, 7, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thomas* with *Tic-Tac-Dough* and *Walker*, as applied to claims 1, 2, 5, 8-11, 20, 23, 27-30 and 36-38 above, in further view of Faciglia, U.S. 5,647,798 (Jul. 15, 1997) (hereinafter "*Faciglia*").

The selection game described by the combination of *Thomas* with *Tic-Tac-Dough* and *Walker* describes all the features of their respective claims except functional symbols that (a) changes the total number of selectios and (b) the number of credits provided to the player. Regardless of these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Faciglia discloses an analogous gaming device wherein player attempts to complete a winning pattern displayed on a matrix. *See fig. 1, 2.* The player completes a pattern by matching random game outcomes with selections in the game matrix. See id. The outcome symbols include numbers corresponding to selections in the matrix and functional symbols that The player accumulates credits for each outcome matching a selection displayed in the matrix. *See col. 5:45-49.* Each functional symbol serves a different "special" function intended enhancing the game. *See col. 3:35-52.* In once case, the player may accumulate "free spin" symbols that allow the player to make additional attempts. *See col. 5:12-19.* In another, the player may receive a "Gold Star" that allow the player additional winnings. *See col. 3:33-52.* In yet another, a special outcome might include a "Devil" symbol that causes the player to lose his accumulated winnings. *See id.* In regards to the claims, *Faciglia* teaches the claimed features of providing functional symbols changing the total number of attempts or modifying the number of credits paid to the player.

In view of *Faciglia*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of *Thomas* with *Tic-Tac-Dough* and *Walker* to add symbols that change the number of selections and award modified the payouts to heighten player's interest in a game in order to increase the game's popularity game and thereby increase operator revenue. See col. 3:33-52.

Claims 16, 17, 18, 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable *Thomas* with *Tic-Tac-Dough* and *Walker*, as applied to claims 1, 2, 5, 8-11, 20, 23, 27-30 and 36-38 above, in further view of Holmes, U.S. 5,882,259 (Mar. 16, 1999) (hereinafter "*Holmes*").

The references above disclose all the features of their respective claims except (1) a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections and (2) a selection confirmation indicator enabling the player to confirm at least one selection picked by the player. Regardless these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Holmes discloses an analogous gaming device where a player selects a set of choice from a matrix of available choices. In particular, a matrix of all possible selections is displayed to the player. *See fig. 3; col. 2:38-3:5.* The player selects a predetermined number of choices and presses "play" to initiate the game after the player has confirmed his choices. *See id.* Subsequently, the player is paid for receiving cards or combinations that match his selections. *See id.*

It would have been obvious to one skilled in the art at the time of the invention to modify the selection-type games described by the combination of *Thomas* with *Tic-Tac-Dough* and *Walker* to add a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections and a selection confirmation indicator enabling the player to confirm each selection picked by the player. One of ordinary skill in the art would also be familiar with games where a player first picks all selections prior to receiving a gaming result. Such systems are commonly seen, for example, in video keno devices. *Holmes* discloses a video poker device that incorporates this feature of picking an entire set of selections from a display and then displaying a game outcome after the player confirms his selections. *See fig. 3.* An artisan of ordinary skill at the time of the invention would have knowledge of single selection games where selections are made individually (e.g. *Thomas*) or, where

selections are made as a group (e.g. *Holmes*). Thus, it would have been a matter of design choice to employ either method. In view of *Holmes*, it would be obvious to provide a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections to provide a player a greater sense of control over the game outcome. The addition would heighten player's interest in a game in order to increase the game's popularity game and thereby increase operator revenue.

Claims 33, 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thomas* with *Tic-Tac-Dough* and *Walker*, as applied to claims 1, 2, 5, 8-11, 20, 23, 27-30 and 36-38 above, in further view Walker, U.S. 6,001,016 (Dec. 12, 1999) (hereinafter "*Walker '016*").

The references above disclose all the features of their respective claims except operating the game through a network or Internet. Regardless these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Walker '016 discloses a system for remote gaming over a network. The system can operate over both local and Internet network systems. *See col. 3:60-4:8. Walker '016* explains the benefits allow players to play a variety of games from a remote location. *See col. 1:19-34.*

In view of *Walker '016*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the selection game described by the combination of *Thomas* with *Tic-Tac-Dough* and *Walker* to allow a greater number of players to access games from remote locations over a network connection and thereby generate greater revenue for the operator.

Response to Arguments

Applicant's arguments with respect to claims 1-13, 15-34 and 36-40 have been considered but are moot in view of the new ground(s) of rejection.

In regards to claims 6 and 7, the applicant argues that there is no suggestion to combine the features of the gaming device disclosed by *Faciglia*, wherein the device randomly generations outcomes, with selection-type games disclosed in *Thomas* and *Tic-Tac-Dough*, wherein players pick outcomes. Furthermore, the applicant argues that improper hindsight was employed in making the combination. The examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion is found in the knowledge generally available to one of ordinary skill in the art. An artisan would possess knowledge of the various display methods for generating outcome selections in gaming devices. For example, these include:

a. Spinning reels wherein selections are distributed on the edge of the reel and selections are picked by the reel's random stopping position. The primary games in *Thomas* and *Mayeroff* fits this category.

b. Roulette wheels wherein selections are distributed on the surface of the wheel and selections are picked by the wheel's random stopping position. The secondary game in *Mayeroff* fits this category.

c. Selection from a matrix (e.g. bingo and keno), wherein a random selection from a pool of possible selections is associated with cells within the matrix wherein a random selection corresponds with the positions of the selections in the matrix. *Faciglia* fits this category.

d. Player selection from a pool of pool of selections randomly distributed to a matrix and concealed. Selection is picked by players' selections that reveal a random selection. The secondary game in *Thomas* and *Walker* fit this category.

These selection methods may differ in their presentation and probabilities, however each serves the equivalent purpose of generating random outcome selections. The random selections chosen from a reel, wheel, or matrix are directly analogous. It is well within the skill of an artisan to employ an outcome selection from one style of game and employ it in another. For example, *Walker* teaches employing outcome selections from a reel-type game and applying them as outcome selections in a selection-type game to provide players with a greater feeling of control over the game's outcome. *See col. 2:38-50.* Thus, it is known in the art to transfer outcome selections between game types. Consequently, it is within the general knowledge of an artisan to employ the "free spin" outcome selection described by *Faciglia*, in a selection-type game, such as disclosed by *Thomas* or *Walker,* to generate random outcome selections while providing players a greater feeling of control over the game's outcome.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it was within the knowledge of one of ordinary skill in the art at the time of the invention to employ a selection outcome from one style of game in a second style of game without employing knowledge taken from the Applicant's disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

SA
October 31, 2002

MARK SAGER
PRIMARY EXAMINER